

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 2876

In re

Patent Application of

Binh T. Lu et al.

Application No. 10/725,047

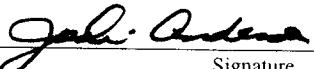
Confirmation No. 2957

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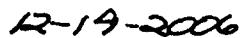
Examiner: Caputo, Lisa M.

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I, Jodi Anderson, hereby certify that this correspondence is being
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REPLACEMENT APPEAL BRIEF TRANSMITTAL

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Sir:

Applicants provide the attached Replacement Appeal Brief in response to the Notices of Non-compliant Appeal Brief dated November 21, 2006, September 5, 2006, and May 16, 2006. The Replacement Appeal Brief also responds to the Office action dated August 24, 2005, in which the Examiner reopened prosecution. As stated in MPEP 1208.02, Applicants may file a reply to the Office action issued by the Examiner or can request reinstatement of the appeal. Applicants hereby request reinstatement of the appeal and provide this Replacement Appeal Brief, as required under 37 C.F.R. § 1.193(b)(2)(ii).

Applicants originally appealed from the final rejection dated October 19, 2004 and the Advisory Action dated March 17, 2005. Applicants note that a Notice of Appeal was filed

March 18, 2005 and received by the Patent Office on March 21, 2005. Applicants have previously paid the fee required under 37 CFR 41.20(b)(2).

The original appeal brief was filed and responded to by the Examiner when prosecution was reopened. After Applicants requested that the appeal continue, the appeal brief was rejected as being non-compliant. Applicants amended the appeal brief and resubmitted a replacement appeal brief to the Patent Office. The replacement appeal brief was reviewed and accepted by the Examiner and an Examiner's Answer was mailed to Applicants on August 9, 2006. A second review of the replacement appeal brief was performed in parallel with the Examiner's review and approval of the replacement appeal brief. The secondary review found several new alleged areas of non-compliance that were not found in the initial review or by the Examiner.

Applicants discussed the Notice of Non-compliant Appeal Brief with Mr. Everett R. Williams in a telephone conversation on September 26, 2006. Applicants acknowledge and appreciate the time spent by Mr. Williams in answering questions regarding the Notice of Non-compliant Appeal Brief dated September 5, 2006.

The Notice of Non-compliant Appeal Brief dated September 5, 2006 included three allegedly non-compliant items. First, the brief was allegedly non-compliant for using the heading "Appendix A" rather than "Claim Appendix". Applicants contend that the use of the title "Appendix A" along with the description in the Status of Claims section that directs the reader to Appendix A satisfies the requirement of the use of "appropriate headings" as recited in 37 C.F.R. 41.37(c). Applicants also note that only the use of "Appendix A" was identified as being non-compliant. The headings "Appendix B" and "Appendix C" were also used in the replacement brief rather than the suggested headings "Evidence Appendix" and "Related Proceedings Appendix" respectively. These headings were not identified as being non-

compliant. Thus, Applicants submit that it is unclear whether titles in 37 C.F.R. 41.37(c) are required or suggested. Although Applicants disagree with the first ground of non-compliance, Applicants amended all of the headings to exactly conform with those suggested in 37 C.F.R. 41.37(c).

The second ground of alleged non-compliance related to the amendment filed February 14, 2006. In the Notice of Non-compliant Appeal Brief dated September 5, 2006, Mr. Williams noted that the Replacement Brief failed to give the status of the amendment filed on February 17, 2005. As discussed and acknowledged by Mr. Williams during the telephone conference, the replacement brief did in fact address this amendment. As such, Mr. Williams has withdrawn this ground of non-compliance. Applicants also note that the correct filing date of the amendment in question is the date the amendment was mailed (February 14, 2005), not the date the amendment was received in the Patent Office (February 17, 2005).

The third ground of alleged non-compliance related to the summary of the claimed subject matter. Specifically, Mr. Williams stated “[t]he brief does not contain a concise explanation of the subject matter defined in each of the independent claims.” Applicants disagree with this contention because the subject matter of the claims was described with reference to the drawings and the specification. In fact, the same Summary of Claimed Subject Matter was submitted in the original brief which resulted in the Examiner re-opening prosecution and the first replacement brief, and it was not then identified as being non-compliant. In the Examiner’s Answer dated August 9, 2006 the Examiner indicated that the Summary of Claimed Subject Matter in the brief was correct.

In light of the foregoing, Applicants required additional clarification as to what was allegedly non-compliant. During the conversation with Mr. Williams, Mr. Williams suggested

that the rules outlined in the MPEP require that Applicants repeat the independent claims, with reference to the drawings and the specification, in the Summary of Claimed Subject Matter section of the brief. Applicants disagree with this conclusion because 37 C.F.R. §41.37(c)(1) refers to a “summary” of the claimed subject matter not a summary of the claims. Applicants believe our original summary adequately described the claimed subject matter. However, Applicants complied and added a recitation of each independent claim in the Summary of Claimed Subject Matter section of the brief.

In light of the foregoing, Applicants submit that both their first replacement brief and the second replacement brief were in substantial compliance with the actual laws and regulations relating to appeal briefs.

In the latest Notice of Non-compliant appeal brief, Examiner Caputo states that the patent appeals specialist Mr. Williams requires that the concise explanation of the subject matter must reference each claim by claim number. Unfortunately for the Applicants, Mr. Williams failed to mention this “requirement” during the telephone conference of September 26, 2006. Examiner Caputo indicated in a telephone conference that she believes Mr. Williams is requiring the phrase “[W]ith regard to claim X” be employed at the beginning of each paragraph that describes a new independent claim.

While Applicants have made the requested amendment to facilitate the movement of this case to the Board, Applicants completely disagree with Mr. Williams’ position. Mr. Williams is creating arbitrary requirements that simply do not exist in the C.F.R. or in the MPEP. Additionally, Mr. Williams is applying these requirements in a piecemeal fashion causing an unreasonable and unnecessary delay in the prosecution of this case. Each time Mr. Williams has

rejected the appeal brief, the rejections were addressed, only to produce new basis for rejections, none of which are supported by the current law or regulations related to appeals.

Nevertheless, Applicants have provided a third Replacement Brief and respectfully request that the Brief and the Appeal proceed to the Board in a timely fashion.

Applicants further request that the attached third replacement brief be identified as compliant as soon as possible to avoid further unnecessary delay and to permit an expeditious filing of a petition to accept the replacement brief, if such a petition becomes necessary.

The undersigned is available for telephone consultation should any additional matters of form arise.

Respectfully submitted,


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